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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/721,045

Applicant(s)

MOSKOWITZ ET AL.

Examiner

Eric A. Wiener

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/22/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 - 11, 14 - 22, 25 - 33, 35, and 37 - 45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 - 11, 14 - 22, 25 - 33, 35, and 37 - 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the following communications: Amendment filed on 5/22/2007.

This action is made final.

2. Claims 3 – 11, 14 – 22, 25 – 33, 35, and 37 – 45 are pending in the case. Claims 3, 4, 14, 15, 25, 26, 35, 37, and 38 are the independent claims. Claims 3 – 11, 14 – 22, 25 – 33, 35, and 37 – 45 are rejected.

Claim Objections

3. Claim 35 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 35 depends on claim 38. A claim may only depend on a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 3, 14, 25, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by

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Storey (US 6,578,012 B1).

As per independent claim 3, Storey discloses *a method comprising:*

- *providing an on-line, interactive network site including a personalized network page (column 5, lines 47 – 57) from which a user can customize and personalize specifications (column 9, line 62 – column 10, line 6) for a three-dimensional achievement recognition item (column 3, lines 14 – 23 and column 7, lines 1 – 9), wherein the distinction made between possible awards of certificates and actual products, indicates that one could request a two-dimensional certificate as an award or a three-dimensional “actual product” as an award.*
- *wherein the personalized network page includes a pre-populated list of one or more achievements attained by the user, any of which the user can select for customizing and personalizing an achievement recognition item (column 8, lines 22 – 45), wherein the accumulation of points has been interpreted as an achievement attained by a user, and wherein said user may select one or more achieved points so as to order an award. In addition, said award is inherently an achievement recognition item because it may only be ordered if said user has achieved the required points;*
- *receiving information through the network site from the user, wherein the information includes user-selected specifications for customizing and personalizing features of the achievement recognition item for an achievement*

selected by the user from the pre-populated list (column 9, line 62 – column 10, line 6); and

- *producing the achievement recognition item in accordance with the user-selected specifications (column 10, lines 9 – 11).*

As per independent claims 14, 25, and 37, the claims are for a system and machine-readable medium for implementing the method of claim 3 and a method of accessing and using the method of claim 3. Storey discloses a system in column 10, lines 29 – 31 and a machine-readable medium in column 13, lines 8 – 10 for implementing the method of claim 3. In addition, a method for accessing and using the method of claim 3 is inherent to the method of providing the method of claim 3. Therefore, Storey also discloses the limitations of claims 14, 25, and 37.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4 – 7, 9, 10, 15 – 18, 20, 21, 26 – 29, 31, 32, 35, 38 – 41, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Successories.com in view of Horn et al. (US 7,013,289 B2) and further in view of Roses (US 2003/0055871 A1).

As per claim 4, Successories.com discloses *a method of providing an online network site from which a user can customize and personalize a three-dimensional achievement recognition item* - “We’ll personalize awards for the stars of your organization” [(PTO-892, page 1,

Reference V), "Successories: #1 Source For Motivational Gifts & Awards," page 1]. The method of providing is exhibited in the fact that the archived web site was provided on the World Wide Web. Successories.com also discloses *producing the achievement recognition item in accordance with the user-selected specifications selected through the web site* - "If you select a product on this web site which requires engraving, you will be prompted during the checkout process to provide the necessary engraving information... Please be sure that your instructions clearly indicate how you wish your engraving to appear. We will engrave the exact letters and spaces we see." [(PTO-892, page 1, Reference W), "Successories: Engraving," pages 1 and 2]. In addition, the forms to enter the user-selected specifications are given on page 2 of 'Successories: Engraving.'

The archived page of Successories.com does not explicitly disclose that said web site is an interactive network site or that said method includes receiving information through the network site from the user, wherein the information includes user-selected specifications for customizing and personalizing features of an item.

However, in an analogous art, Horn discloses a *method of providing an online, interactive network site* (column 36, lines 9 – 65) *from which a user can customize and personalize specifications for an item* (column 15, lines 61 – 65). Horn also discloses a *method of receiving information through the network site from the user* (column 38, lines 11 – 14), *wherein the information includes user-selected specifications for customizing and personalizing features of the item* (column 15, lines 61 – 65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the teachings of Horn with the teachings of Successories.com to develop

a method of providing an online, interactive web site in which a user can personalize an achievement recognition item to be produced in accordance with selected personalized specifications. The modification would have been obvious, because the e-commerce site of Horn would permit any and all items to be customized and sold, thereby including achievement recognition items (Horn, column 1 lines 34 – 38). In addition, many compelling trends and powerful developments have conjoined to permit the construction and operation of a complete and integrated online system of global trade to meet long-felt needs, wherein a custom product can be created to satisfy a buyer's needs, and suppliers are enabled to provide necessary business-to-business products and services on a timely basis (Horn, column 2 line 29 – column 3, line 13). Thus, it would be obvious to combine the Successories.com website with the e-commerce methods of Horn to produce an achievement recognition item e-commerce website.

Additionally, neither Successories.com nor Horn explicitly disclose that the method of claim 4 includes providing to the user through the online interactive network site a sample image of the achievement recognition item and also includes updating the image, in response to receiving user input through the network site, in accordance with user-selected specifications for customized and personalized features of the achievement recognition item.

However, in an analogous art, Roses discloses *providing to the user through the online interactive network site a sample image of the achievement recognition item* ([0043], lines 1 – 6) *and also updating the image, in response to receiving user input through the network site, in accordance with user-selected specifications for customized and personalized features of the achievement recognition item* ([0043], lines 19 – 21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the method of Horn and Successories.com with the teaching of Roses to develop a method of providing an online, interactive web site in which a user can personalize an achievement recognition item to be produced and wherein said user can preview a sample image of an achievement recognition item and also preview updates to said sample image corresponding to said users customizations. Whenever the user has the ability to customize an item for purchase on a web site, they would oftentimes like the benefit of viewing a preview of their item displaying how the finished, customized item should look. It is well known in the art that e-commerce web sites can and have been employing this functionality for any and all items that can be customized. Thus it would be obvious for an e-commerce web site to employ this method, especially for an item that is to be customized with text, such as an achievement recognition item. In addition, it is obvious that the inventive feature of being able to preview a customized item before purchase applies to *any and all* items, two-dimensional or three-dimensional, that are to be customized for purchase from an e-commerce web site.

As per claim 5, Successories.com, Horn, and Roses substantially disclose the method of claim 4. In addition, Successories.com further discloses that *the achievement recognition item comprises text that reflects an achievement attained by the user* - "Acknowledge valuable contributions with our Essence of... award, which is designed to inspire people where they work. This attractive black aluminum-framed award comes complete with... a black engravable plate" [(PTO-892, page 2, Reference U), "Successories: Product / Engraved Awards / Item Detail," page 1]. The examiner has interpreted the fact that the award is meant to acknowledge

contributions and that it comes with an engravable plate is sufficiently equivalent to the ability of the achievement recognition item to comprise text reflecting an achievement attained by the user.

As per claim 6, Successories.com, Horn, and Roses substantially disclose the method of claim 5. In addition, Successories.com further discloses that *the achievement recognition item comprises a document mounted on or embedded in a substrate, wherein the document reflects an achievement attained by the user* – “Each framed print is painstakingly mounted by hand,” “Each piece of glass used to protect our prints is washed before it is assembled to ensure image clarity. Unlike most framing glass, it is significantly stronger” [(PTO-892, page 2, Reference V), “Successories: Quality Framing,” page 1]. The examiner has interpreted the fact that the item is framed within glass to be sufficiently equivalent to it being embedding within a substrate.

As per claim 7, Successories.com, Horn, and Roses substantially disclose the method of claim 6. In addition, Successories.com further discloses that *the user-selected specifications include a substrate material*. On page 1 of (PTO-892, page 2, Reference X), ‘Successories: Product / Engraved Awards / Item Detail,’ the user is provided with various styles of the award to select from, of which the substrate materials aluminum and wood are available.

As per claim 9, Successories.com, Horn, and Roses substantially disclose the method of claim 5. In addition, Successories.com further discloses that *the user-selected specifications include text that reflects the achievement by the user* - “If you select a product on this web site which requires engraving, you will be prompted during the checkout process to provide the necessary engraving information... Please be sure that your instructions clearly indicate how you wish your engraving to appear. We will engrave the exact letters and spaces we see.” [(PTO-892,

page 1, Reference W), "Successories: Engraving," pages 1 and 2). In addition, the forms to enter the text are given on page 2 of 'Successories: Engraving.'

As per claim 10, Successories.com, Horn, and Roses substantially disclose the method of claim 5. In addition, Successories.com further discloses that *the achievement recognition item comprises an engraved plate mounted on a substrate* "Acknowledge valuable contributions with our Essence of... award, which is designed to inspire people where they work. This attractive black aluminum-framed award comes complete with... a black engravable plate" [(PTO-892, page 2, Reference X), "Successories: Product / Engraved Awards / Item Detail," page 1], *wherein the user-selected specifications include text to be engraved on the plate* - "If you select a product on this web site which requires engraving, you will be prompted during the checkout process to provide the necessary engraving information... Please be sure that your instructions clearly indicate how you wish your engraving to appear. We will engrave the exact letters and spaces we see." [(PTO-892, page 1, Reference W), "Successories: Engraving," page 1]. In addition, the forms to enter the text for engraving are given on page 2 of 'Successories: Engraving.'

As per claims 15 – 18, 20, and 21, the claims are for a system for implementing the methods of claims 4 – 7, 9, and 10.

Horn discloses *a system comprising a computer network, user device including a display coupled to the network, and circuitry coupled to the network in order to provide said web site* (column 29, lines 9 – 29) *as well as to receive* (column 38, lines 11 – 14) *and store* (column 29, lines 9 – 29) *information through the network site from the user.*

Therefore, claims 15 – 18, 20, and 21 are rejected for the reasons as claims 4 – 7, 9, and 10.

As per claims 26 – 29, 31, and 32, the claims are for an article for implementing the methods of claims 4 – 7, 9, and 10.

Horn also discloses *an article comprising a machine-readable medium storing machine-executable instructions that, when applied to a machine cause the machine to provide said web site and store information received through the network site from the user* (column 29, lines 9 – 29).

Therefore, claims 26 – 29, 31, and 32 are rejected for the reasons as claims 4 – 7, 9, and 10.

As per claims 38 – 41, 43, and 44, the claims are for methods for using the methods of claims 4 – 7, 9, and 10.

Successories.com also discloses *a method of accessing an online network site*. The method of accessing is exhibited in the fact that the archived web site was provided on the accessible World Wide Web. Additionally, Successories.com discloses a method of *entering information through the network site to order the item, wherein the information includes user-selected specifications for customizing and personalizing features of an item* - “If you select a product on this web site which requires engraving, you will be prompted during the checkout process to provide the necessary engraving information... Please be sure that your instructions clearly indicate how you wish your engraving to appear. We will engrave the exact letters and spaces we see.” [(PTO-892, page 1, Reference W), “Successories: Engraving,” pages 1 and 2]. In

addition, the forms to enter ordering and personalization information are given on pages 1 and 2 of 'Successories: Engraving.'

Therefore, claims 38 – 41, 43, and 44 are rejected for the reasons as claims 4 – 7, 9, and 10.

As per claim 35, the claim is improper for depending on a later claim. Nevertheless, Successories.com, Horn, and Roses substantially disclose the method of claim 38. In addition, Successories.com further discloses *receiving an achievement recognition item in accordance with the user-selected specifications* – “Any framed print can be shipped to you or a location you specify” [(PTO-892, page 2, Reference V), “Successories: Quality Framing,” page 2], where the examiner has interpreted the method of enabling the shipping of an item to be sufficiently equivalent to the method of enabling the receiving of an item, since receiving a shipped item is the logical effect of shipping it.

8. Claims 8, 11, 19, 22, 30, 33, 42, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Successories.com, Horn et al. (US 7,013,289 B2), and Roses (US 2003/0055871 A1) in view of Leone, III et al. (US 6,665,587 B2).

As per claim 8, Successories.com, Horn, and Roses substantially disclose the method of claim 6. Neither Successories.com, Horn, nor Roses explicitly discloses that the user-selected specifications include color.

However, in an analogous art, Leone, III discloses *user-selected specifications including color* (column 4, lines 42 – 57).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the method of Successories.com, Horn, and Roses with the teaching of Leone, III to develop a method of providing an online, interactive web site in which a user can personalize an achievement recognition item to be produced and wherein the personalization includes the ability to choose different colors. It is well known in the art of personalizing items that when personalizing an item that is available in a color, the opportunity to select different colors is common. Leone discloses a method of providing computer-implemented interface for selecting and personalizing items, in which different colors of the item can be selected. This interface is not unlike interfaces of computer-implemented e-commerce sites allowing the selection and personalization of items. Thus, it would be obvious to combine the ability of Leone's interface with the web site of Successories.com, Horn, and Roses in order to provide the ability to select different colors.

As per claim 11, Successories.com, Horn, and Roses substantially disclose the method of claim 10. Neither Successories.com, Horn, nor Roses explicitly discloses that the user-selected specifications include type style or font size of the text.

However, in an analogous art, Leone, III discloses *user-selected specifications including type style or font size of text* (column 4, lines 42 – 57), wherein a font itself is a type style.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the method of Successories.com, Horn, and Roses with the teaching of Leone, III to develop a method of providing an online, interactive web site in which a user can personalize an achievement recognition item to be produced and wherein the personalization includes the ability to engrave text in different selected sizes and styles. It is well known in the

art of personalizing items that when personalizing an item that includes text, the opportunity to select the size or style of such text is common. Leone discloses a method of providing computer-implemented interface for selecting and personalizing items, in which text can be included in different selected sizes or styles. This interface is not unlike interfaces of computer-implemented e-commerce sites allowing the selection and personalization of items. Thus, it would be obvious to combine the ability of Leone's interface with the web site of Successories.com, Horn, and Roses in order to provide the ability to select different sizes and styles of text.

As per claims 19, 30, and 42, the claims are substantially similar to claim 8 and are therefore rejected for the same reasons as claim 8.

As per claims 22, 33, and 45, the claims are substantially similar to claim 11 and are therefore rejected for the same reasons as claim 11.

Response to Arguments

9. Applicant's arguments filed on 5/22/2007, with respect to claims 3, 14, 25, and 37 have been fully considered but are moot in view of the new grounds of rejection.

Applicant's arguments filed on 5/22/2007, with respect to claims 4, 15, 26, and 38 have been fully considered but are not persuasive.

10. The applicant has argued that one of ordinary skill in the art would not have been motivated to combine the preview ability of Roses with the web site of Successories.com and Horn et al.

The examiner disagrees, because, as per the rejection of claim 4 *supra*, it is obvious that the inventive feature of being able to preview a customized item before purchase applies to *any and all* items that are to be customized for purchase from an e-commerce web site. In previewing an image of an item on a web site displayed on a computer screen when viewed as a single image, the image is viewed as a two-dimensional projection onto the screen, no matter if the item itself is three-dimensional. Therefore the ability to preview an image of an item for purchase would be applicable to any item viewed as a single image on screen. In addition, the fact that a user-selected specification may be a substrate material does not overcome the rejections, because in previewing an updated image of a new substrate material, only the color of the portion of the image corresponding to the substrate material will change, therefore the image would be updated just as an image of Roses would be updated.

Conclusion

11. It is noted that any citation to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

12. The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure. The cited documents represent the general state of the art.

13. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Wiener whose telephone number is 571-270-1401. The examiner can normally be reached on Monday through Thursday from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo, can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric Wiener
Patent Examiner
A.U. 2179



BA HUYNH
PRIMARY EXAMINER